

REMARKS

Applicant has carefully reviewed the Office Action dated December 17, 2002. Applicant has amended Claims 1, 12, 13, 16, 17, 18 and 21 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

The Examiner had noted that, since the election of species A in Paper No. 11 was acknowledged without traverse, the Examiner has treated this as an election without traverse.

Claims 1-22 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Ogasawara*. This rejection is respectfully traversed with respect to the amended claims.

Applicant's present invention, as it is defined by the amended claims, is directed toward a system wherein a user, upon entering the store, is provided with a personal scanner. This personal scanner allows the user to scan a machine resolvable code (MRC) which, in one instantiation, comprises a UPC or bar code. When the MRC is scanned by the personal scanner, a transaction is initiated. A retail processing system is made aware of the fact that a particular user has possession of a particular scanner, made by an association created prior to the user receiving the scanner. Therefore, whenever an MRC is scanned with the personal scanner provided to that user, the retail processing system will be able to receive information from that scanner and have information in its database to allow an association to be made between the received information and the user that was given the personal scanner. This is facilitated by transferring to the retail processing system both the MRC that was scanned and the unique ID of that particular scanner all in response to the step of scanning. It is only necessary then to refer to a relational database in the retail processing system's database to determine what user was associated with that unique personal scanner ID again, all in response to the step of scanning. Once this information has been discerned by the retail processing system, then the transaction is complete, i.e., a user may have their credit card debited for the amount of the transaction, the amount of the transaction being placed on store credit or any other manner by which to close a transaction. The result is that the user has now purchased the product and owns the product. The user can transfer this product to someone else, can utilize the product or can merely dispose of the product. However, the retail

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establishment or entity has no interest in that particular product once the product is scanned. Therefore, the act of scanning the MRC initiates a transaction which then is completed upon the receipt of a valid personal scanner ID that is associated with a valid user without requiring the user to view any display, or take any action other than the mere scanning of the MRC in order to complete the transaction and transfer ownership of that product to the user such that the transaction will then be complete.

Ogasawara, cited by the Examiner, is directed toward a portable shopping system. This shopping system allows a user to be provided with a portable shopping terminal which can have information loaded therein by the user. In one paragraph, pointed out by the Examiner, beginning at Col. 10, line 25, *Ogasawara* sets forth that each portable terminal is assigned a unique terminal ID and any communication from the portable terminal to the store's core server will be identified by that unique terminal ID. This portion of the Specification of *Ogasawara* is set forth as follows:

Pertinent to transferring a customer's shopping list to either the store's core server or to a customer's mobile terminal is that the electronic shopping system according to the invention includes means to identify each terminal to the core server so that each individual customer's transactions can be maintained separately. In particular, each terminal is assigned a unique terminal ID and all communications between that terminal and the store's core server are identified by that unique terminal ID. Alternatively, each customer is issued a unique customer ID which may be used by the mobile terminal as a unique identification flag such that transmissions between a mobile terminal and the store's core server can be allocated to a particular customer. If the mobile terminal communicates with a core server by using the terminal's ID the terminal will necessarily provide the customer's ID information to the core server so that transactions made by that terminal are allocated to that customer.

It can be seen from this insert that the mobile terminal can also have a unique customer ID associated with a customer that is set forth as being used by the mobile terminal as a unique identification flag. It is unclear whether the customer ID is used at the core server or it is used at the mobile terminal. However, the last sentence of this excerpt seems to indicate that there will be some association between the terminal ID and the customer's ID information.

In general, this mobile personal shopping system and the mobile terminal associated therewith allow a customer to visit a retail shopping facility and have associated with that mobile terminal a list of all the items that they desire to purchase. There may be items that they desire to purchase that are actually not at that retail establishment. Further, this system is not made for the purpose of completing a transaction and actually purchasing the items. Rather, a user will utilize the personal shopping system to keep a list of products that they may want to purchase, i.e., a wish list for example, and then visit retail establishments. At the retail establishment, the user can utilize this portable terminal for the purpose of determining where in the store a particular item is located, if at all. If a purchase is then made, this is updated by the retail establishment to some type of central server. This is for the purpose of maintaining the history of that particular user. With respect to Figure 5b, beginning at Col. 14, line 51, it is set forth that there is some type of purchase interval that is to be examined. Since there is a purchase interval, there is some amount of time between the time the data is entered into the shopping list and when an item is actually purchased. In general, the scanning operation is for the purpose of defining a customer's current location; however, there is no disclosure set forth in *Ogasawara* that utilizes the scanning operation to both extract the encoded information therefrom, associate that encoded information with the unique information associated with the user, i.e., in the dependent claims the unique idea of the personal scanner, and then, *complete* the transaction, all as a result of the scanning operation. In fact, it appears that one of the primary uses for this system is to maintain a history of purchased and unpurchased items which can be utilized for the customer to determine future shopping trips, and that can also be used by the store's management personnel for the purpose of analyzing items that the store did not have that were on a person's list or items that were not purchased by the buyer and were purchased elsewhere. This is described at Col. 16, beginning at line 12.

In view of the above arguments, Applicant believes that *Ogasawara* does not anticipate or obviate applicant's present inventive concept as defined by Claims 1-22 and, therefore, respectfully requests withdrawal of the 35 U.S.C. § 102(e) rejection with respect to Claims 1-22.

Claims 1-5 and 12-16 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by *Barnett*. This rejection is respectfully traversed. *Barnett* is a system that is distinctly different than the *Ogasawara* reference. *Barnett* is a shoe-size scanner system. This does not provide a portable unit that can be given to a user and associated with the unique identification information of the user. Rather, as

set forth in Col. 4, beginning at Line 41, the portable units are only intended for use by sales clerks. Although they may have an ID, this ID is only for the purpose of recognizing that scanner by a simple server. However, there is no reason to recognize this portable unit, since this is merely for accessing inventory information by the sales clerk. There are fixed units that are provided for use by either customers or sales clerks, these also having the primary purpose for displaying inventory information about a particular shoe. This is facilitated by scanning an MRC or UPC on the particular product. This is used by the sales clerk or the customers to determine if a particular shoe that they desire with a particular size, color is and size is in stock. There is no disclosure that unique identification information associated with the user is in any way associated with a step of extracting, nor is there any disclosure that the operation of extracting the information in the MRC code in any way allows a transaction to be completed in response to the step of extracting. Therefore, Applicant respectfully requests the withdrawal of the 35 U.S.C. §102(e) rejection with respect to Claims 1-5 and 12-16.

not true
 The Examiner had noted in Item 8 of the Office Action that no patentable weight was given to the functional language. However, Applicant traverses this position in that functional language utilized with an element in an apparatus claim may be given patentable weight if it is necessary to describe that element and if it further limits that element. For example, the term “extracting circuit” can have many uses and that term by itself can be limited by what the extraction circuit is utilized for. For example, it could be an extraction circuit for extracting data; it could be an extraction circuit for extracting frequency information; or, as in this claim, an extraction circuit for extracting encoded information. Therefore, the recitation of the intended use as set forth in this claim, is used to provide a structural difference between a “extraction circuit” in general and that as utilized in conjunction with the present invention, i.e., used for extracting encoded information such as would be the case for a bar code scanner.

Applicant confirms that a conversation was had between the undersigned and the Examiner wherein the Examiner inquired about whether the undersigned would agree that a statement would be made in the record that “Applicant intended to be his own lexicographer.” Applicant believes that this is not required and is not necessary in order to determine the meaning of the claims. The claims are believed to be sufficiently clear that the meaning of each term can be discerned from the term itself or, if necessary, from the reading the specification. Thus, the undersigned did not approve such a statement as it was believed to be unnecessary.

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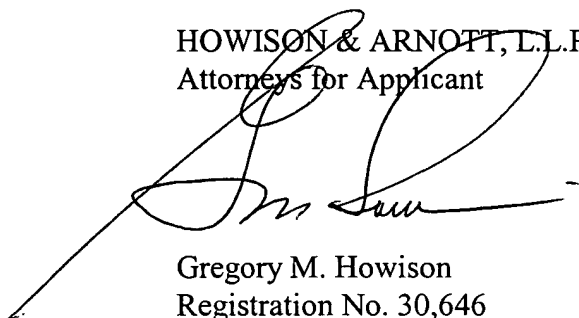
Claims 1-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ogasawara*. This rejection is respectfully traversed for the reasons described hereinabove. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection with respect to Claims 1-11 as there is no disclosure set forth or teaching set forth that would allow one skilled in the art to utilize a shopping system that has a primary purpose of keeping a list for the purpose of initiating a transaction and completing a transaction merely by scanning an MRC.

The Examiner has noted that final step in the transfer of ownership as argued in the previous Response may be missing from *Ogasawara* and *Barnett*. Applicant has amended the claims to further clarify the claims in that the ownership is transferred in response to the steps of scanning and transferring.

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-25,357 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,

HOWISON & ARNOTT, L.L.P.
Attorneys for Applicant



Gregory M. Howison
Registration No. 30,646

GMH:keb

P.O. Box 741715
Dallas, Texas 75374-1715
Tel: 972-479-0462
Fax: 972-479-0464
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